

Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claims 1, 9, 13, 21 and 25 have been amended. No claims have been added or canceled. Thus, claims 1-25, 30, 31 and 35-37 are pending.

CLAIM REJECTIONS – 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1, 13 and 25 were rejected as being indefinite as failing to distinctly claim the invention. Specifically, the phrase “substantially simultaneously” allegedly renders the claims indefinite. Claims 1, 13 and 25 have been amended to remove the phrase “substantially simultaneously.” Accordingly, Applicants request that the rejection of claims 1, 13 and 25 as being indefinite be withdrawn.

CLAIM OBJECTIONS

Claims 9 and 21 were objected to as being a run-on sentence. Claims 9 and 21 have been amended to add the word “is” as suggested by the Office Action. Accordingly, Applicants request that the objection to claims 9 and 21 be withdrawn.

CLAIM REJECTIONS – 35 U.S.C. § 102(e)

Claims 1-7, 9, 10, 12-19, 21, 22, 24, 25, 30, 31 and 35-37 were rejected as being anticipated by U.S. Patent No. 6,370,527 B1 issued to Singhal (*Singhal*). For at least the reasons set forth below, Applicants submit that claims 1-7, 9, 10, 12-19, 21, 22, 24, 25, 30, 31 and 35-37 are not anticipated by *Singhal*.

Claim 1 recites:

generating, automatically with an electronic device without user intervention, ***a local network search request*** in response to an original search request, the local network search request to cause a search to be performed on electronic documents unconsciously captured by a local network device, wherein the unconsciously captured documents are stored by a device that is part of a local network, the search of the electronic documents unconsciously captured to be performed according to search parameters of the original search request;

generating, automatically with the electronic device without having to wait for a search result of the local network search request from the local network and ***in addition to the local network search request, an external network search request in response to the original search request***, the external network search request to cause a search to be performed on electronic documents available from devices that are part of an external network via a network portal of an external network according to the search parameters of the original search request; and

generating ***a single search report at the electronic device based on the search results of the local network search request and the external network search request.***

Thus, Applicants claim in response to a single original search request, generating a local network search request ***and*** an external network search request, with the results of the local network search and the external network search presented as a single search report.

Claim 13 is drawn to a machine-readable medium and recites similar limitations.

To anticipate a claim, the reference must teach every element of the claim. MPEP

§ 2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

However, the Final Office Action does not address generation of a local network search request in response to an original search request. Therefore, Applicants submit that the rejection of claims 1 and 13 is incomplete.

In contrast to the claimed invention, *Singhal* discloses an aggregation of search reports from multiple external searches. See, for example, Figure 3. *Singhal* discloses performing multiple searches using multiple search engines. See col. 2, lines 24-28. However, *Singhal* does not disclose one of the multiple searches being a search of a local network. Therefore, *Singhal* cannot anticipate the invention as claimed in claims 1 and 13.

Claims 2-7, 9, 10, 12 depend from claim 1. Claims 14-19, 21, 22 and 24 depend from claim 13. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2-7, 9, 10, 12, 14-19, 21, 22 and 24 are not anticipated by *Singhal* for at least the reasons set forth above.

Claim 25 recites:

an application to be executed by the first device to search the captured electronic documents in response to a search request, wherein the application also generates an external document search request in response to the search request without having to wait for a search result of the local network;
wherein the first device transmits the external document search request to a second device on an external network, wherein the second device on the external network performs the external document search request to generate a search of electronic documents from an external network...

Thus, Applicants claim an application on a first device searching documents captured from a local network and a second device performing an external document search.

As discussed above, *Singhal* discloses performing multiple external searches and does not disclose performing a search on a local network. Therefore, *Singhal* cannot anticipate the invention as claimed in claim 25.

Claims 30, 31 and 35-37 depend from claim 25. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 30, 31 and 35-37 are not anticipated by *Singhal* for at least the reasons set forth above.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

Claims 11 and 23 were rejected as being unpatentable over *Singhal* in view of U.S. Patent No. 5,913,040 A issued to Rakavy, et al (*Rakavy*). For at least the reasons set forth below, Applicants submit that no combination of *Singhal* and *Rakavy* can teach or suggest the invention as claimed in claims 11 and 23.

Claim 11 depends from claim 1 and claim 23 depends from claim 13. *Rakavy* is cited to teach a search report having an advertisement selected based on the search results. See page 8 of the Final Office Action. However, whether or not *Rakavy* discloses the selection of advertisements, *Rakavy* does not cure the deficiencies of *Singhal* set forth above. Therefore, no combination of *Singhal* and *Rakavy* can teach or suggest the invention as claimed in claims 11 and 23.

Claims 8 and 20 were rejected as being unpatentable over *Singhal* in view of U.S. Patent No. 6,263,332 B1 issued to Nasr, et al (*Nasr*). For at least the reasons set forth below, Applicants submit that no combination of *Singhal* and *Nasr* can teach or suggest the invention as claimed in claims 8 and 20.

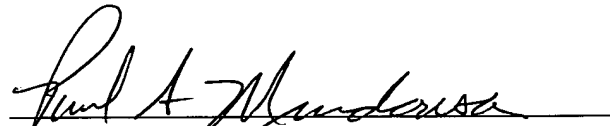
Claim 8 depends from claim 1 and claim 20 depends from claim 13. *Nasr* is cited to teach a search report as either HTML or XML. See page 9 of the Final Office Action. However, whether or not *Nasr* discloses HTML and/or XML search results, *Nasr* does not cure the deficiencies of *Singhal* set forth above. Therefore, no combination of *Singhal* and *Nasr* can teach or suggest the invention as claimed in claims 8 and 20.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-25, 30, 31 and 35-37 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: Aug 16, 2004



Paul A. Mendonsa
Attorney for Applicant
Reg. No. 42,879

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(503) 439-8778